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James P. Lester

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AXIOS LAW GROUP, PLLC / REALNETWORKS, INC
1525 4TH AVE, STE 800
SEATTLE, WA 98101-1648

EXAMINER

SIDDIQI, MOHAMMAD A

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/021,752	Applicant(s) LESTER ET AL.	
	Examiner MOHAMMAD A. SIDDIQI	Art Unit 2454	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 January 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 and 26-31 is/are pending in the application.
- 4a) Of the above claim(s) 12-25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 and 26-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-11 and 26-32 are presented for examination. Claims 12-25 have been withdrawn from the consideration.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 01/13/2009 has been entered.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

4. Claims 1-4, 6-7, 9-11, 26-29 and 31-32 are rejected under 35 U.S.C. 102(e) as being anticipated by Day et al. (5,996,015) (Hereinafter Day).

5. As per claim 1, Day discloses computer implemented method of delivering digital media items to a user electronic device, the method comprising;

obtaining at the computer a playlist comprising a sequentially (col 2, line 40) ordered plurality of digital media items that satisfies a set of restrictive criteria (fig 2, col 2, lines 29-52; col 4, lines 23-40, Set of restrictive criteria: "the server includes a tool that automatically determines the encoding type, frame rate and play rate when content is loaded through HTML forms. **The attributes for a file can be complemented by additional information describing the asset. Such information, which may be defined by the user, can include additional informational items such as title, subject, actors, director, and date released** as hereinbefore noted.");

playing said playlist by the computer (203, fig 2), wherein playing said playlist comprises sequentially (col 2, line 40) delivering to the user electronic device (fig 2, col 2, lines 29-52; col 4, lines 23-40), via a computer network (105, fig 1), said sequentially ordered plurality of digital media items (fig 2, col 2, lines 29-52; col 4, lines 23-40); and (105, fig 1) the digital media items in a sequential order from a playlist (col 2, lines 40-44),

while the computer is playing the playlist (user can add, delete, change and view attributes of the assets; col 3, lines 50-65; col 4, lines 1-12);

receiving, from the user electronic device, an indication to add a requested digital media item to the playlist user can add , delete, change and view attributes of the assets; col 3, lines 50-65; col 4, lines 1-12:

evaluating whether adding the requested digital media item to the playlist would satisfy the set of restrictive criteria (col 4, lines 8-40; Set of restrictive criteria : “the server includes a tool that automatically determines the encoding type, frame rate and play rate when content is loaded through HTML forms. **The attributes for a file can be complemented by additional information describing the asset. Such information, which may be defined by the user, can include additional informational items such as title, subject, actors, director, and date released** as hereinbefore noted.”); and

when the set of restrictive criteria is satisfied, selectively adding the indication of the requested digital media item to the playlist for delivery to the user electronic device (multimedia assets are placed in a file system, col 4, lines 24-26) subsequent to receipt of the request (col 4, lines 8-40; Set of restrictive criteria: “the server includes a tool that automatically determines the encoding type, frame rate and play rate when content is loaded through HTML forms. **The attributes for a file can be complemented by additional information describing the asset. Such information, which may be defined by the user, can include additional informational items such as title, subject, actors, director, and date released** as hereinbefore noted.”).

6. As per claim 2, Day discloses the set of restrictive criteria comprises whether the playlist satisfies a set of group preferences (col 4, lines 56-64; col 5, lines 53-60).

7. As per claim 3, Day discloses the adding comprises inserting a requested media item at a random position in the playlist (items are inserted on-the-fly prior to the end of the stream [page 15, lines 10-11 of the specification], col 6, lines 37-64).

8. As per claim 4, Day discloses attempting to add the requested media item to a position in the playlist so that the modified playlist satisfies the set of restrictive criteria (user can add attributes of assets and these attribute tells server how to serve the request [please see page 11, 4-6 of the specification], col 4, lines 8-22; lines 42-55; col 5, lines 53-58); and disregarding the request if the requested media item cannot be added to the playlist so that the modified playlist would satisfy the set of restrictive criteria (303, 305, fig 3, col 6, lines 14-25, before the item of different operating characteristics' added to the list is converted to satisfy the operating criteria).

9. As per claim 6, Day discloses the delivering media items comprises broadcasting media items to the user electronic (col 4, lines 56-64) device, and wherein said set of restrictive criteria comprises whether fewer than a substantial number of media items are delivered (col 6, lines 51-57).

10. As per claim 7, Day discloses the delivering media items further comprises broadcasting media items to the user electronic device, and wherein said set of restrictive criteria comprises whether fewer than a substantial number of media items are delivered at a time that the user electronic device is informed the requested media items will be delivered (col 4, lines 56-64, please see summary of the invention).

11. As per claim 9, Day discloses providing a searchable database of media items that allows at least one of the user electronic devices to search the database by a set of media attributes (col 3, lines 39-45);
receiving a request from one or more of the user electronic devices for a media item from the database (col 3, line 63- col 4, line 2); and
selectively adding the requested media item from the database to the playlist if the modified playlist would satisfy the set of restrictive criteria (dynamically generating the play list, col 4, lines 42-50).

12. As per claim 10, Day discloses the adding comprises limiting the number of requests from at least one of the user electronic devices (selective access, col 5, lines 53-59).

13. As per claim 11, Day discloses the media items are sound recordings (MPEG compressed audio, col 3, line 25).

14. As per claim 26, the claim is rejected for the same reasons as claim 1, above. In addition, Day discloses one or more media servers for delivering digital media files to a plurality of client electronic devices over a computer network (fig 2), the one or more media servers comprising:

a network connection for communicatively coupling one or more of the media servers with the plurality of client electronic devices over the computer network (fig 2, col 2, lines 28-36);

a playlist memory containing a playlist, wherein the playlist comprises a sequentially ordered plurality of digital media items that satisfies a set of restrictive criteria (col 2, lines 40-44; col 4, lines 8-64; Set of restrictive criteria : “the server includes a tool that automatically determines the encoding type, frame rate and play rate when content is loaded through HTML forms. **The attributes for a file can be complemented by additional information describing the asset. Such information, which may be defined by the user, can include additional informational items such as title, subject, actors, director, and date released** as hereinbefore noted.”);

a media storage memory containing a library of the digital media files (col 3, lines 43-45); and

a processor coupled with the network connection, the playlist memory (fig 2), and the media storage memory the processor operative (fig 2) to:

play the playlist by transmitting digital media files according to the sequential order indicated by the playlist (col 2, lines 28-50) from the media storage memory to the plurality of client electronic devices over the computer network (col 4, lines

8-40; Set of restrictive criteria: “the server includes a tool that automatically determines the encoding type, frame rate and play rate when content is loaded through HTML forms. **The attributes for a file can be complemented by additional information describing the asset. Such information, which may be defined by the user, can include additional informational items such as title, subject, actors, director, and date released** as hereinbefore noted.”); and while the playlist is playing:
evaluate requests to add a requested digital media item to the playlist from one or more of the client electronic devices using the set of criteria (col 3, line 65 – col 4, line 7); and
upon at least one of the requests would satisfying the set of criteria (col 4, lines 8-64; Set of restrictive criteria : “the server includes a tool that automatically determines the encoding type, frame rate and play rate when content is loaded through HTML forms. **The attributes for a file can be complemented by additional information describing the asset. Such information, which may be defined by the user, can include additional informational items such as title, subject, actors, director, and date released** as hereinbefore noted.”), add an indication of the requested digital media file to the playlist for delivery to the user electronic device subsequent to receipt of said at least one of the requests (dynamically generating the play list, col 4, lines 42-50).

15. As per claim 27, the claim is rejected for the same reasons as claims 26 and 6, above.

16. As per claim 28, the claim is rejected for the same reasons as claims 26 and 2, above.

17. As per claim 29, the claim is rejected for the same reasons as claims 26 and 11, above.

18. As per claim 31, the claim is rejected for the same reasons as claims 26 and 7, above.

19. As per claim 32, the claim is rejected for the same reasons as claim 26, above. In addition, Day discloses the set of restrictive criteria comprises a set of group preferences to each network media channel (col 4, lines 56-64).

Claim Rejections - 35 USC § 103

20. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 2454

21. Claims 5, 8, 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Day et al. (5,996,015) (Hereinafter Day) in view of Rothman et al. (US 2001/0044851) (Hereinafter Rothman).

22. As per claim 5, Day fails to disclose the set of restrictive criteria comprises whether the playlist complies with the Digital Millennium Copyright Act requirement for obtaining a statutory license. However, Rothman discloses the set of restrictive criteria comprises whether the playlist complies with the Digital Millennium Copyright Act requirement for obtaining a statutory license (para #0024). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the teachings of Rothman with Day. The motivation would have been to make the system DMCA Compliant.

23. As per claim 8, Day fails to disclose the delivering media items comprises broadcasting media items to one or more of the user electronic devices so that the media items are delivered in compliance with the Digital Millennium Copyright Act requirement for obtaining a statutory license. However, Rothman discloses the delivering media items comprises broadcasting media items to one or more of the user electronic devices so that the media items are delivered in compliance with the Digital Millennium Copyright Act requirement for obtaining a statutory license (para #0024). It would have been obvious to one of ordinary skill in the art at the time of the invention to

incorporate the teachings of Rothman with Day. The motivation would have been to make the system DMCA Compliant.

24. As per claim 30, the claim is rejected for the same reasons as claim 5, above. In addition, Rothman discloses the playlist memory contains a plurality of playlists, each playlist corresponding to a network media channel (Multicast, para #0016-#0017); the processor is adapted to receive requests for digital media files from the plurality of client electronic devices (para#0060), each request being associated with a network media channel (para #0074), wherein the processor evaluates each request using one or more restrictive criteria (para #0097) and, if the playlist (para #0073) including the requested media file would satisfy the set of restrictive criteria (para #0097) , adds the requested digital media file to the playlist (para #0097) ; and the one or more media servers broadcast digital media files sequentially to the network on each of the plurality of network media channels according to each corresponding playlist (para #0073; para #0074) .

Response to Arguments

25. Applicant's arguments with respect to claims 1-11 and 26-32 have been considered but are moot in view of the new grounds of rejection.

Conclusion

26. Any inquiry concerning this communication or earlier communications from the examiner should be directed to MOHAMMAD A. SIDDIQI whose telephone number is (571)272-3976. The examiner can normally be reached on Monday -Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan J. Flynn can be reached on (571) 272-1915. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MS

***/Nathan J. Flynn/
Supervisory Patent Examiner, Art Unit 2454***